

REMARKS

Status of the Claims

- Claims 1-18 are pending in the Application after entry of this amendment.
- Claims 1-18 are rejected by Examiner.

Claim Rejections Pursuant to 35 U.S.C. §103

Claims 1-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,991,741 to Speakman et al. in view of Charnes et al. (Comparison of DEA and Existing Ratio and Regression Systems for Effecting Efficiency evaluations of Regulated Electric Cooperatives in Texas).

A prima facie case for obviousness under § 103(a) requires three elements. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be some reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach all of the claim limitations. (MPEP 706.02(j)). Applicant respectfully submits that the Examiner has failed to make out a prima facie case because there is no suggestion or motivation to combine the references of Speakman et al. and Charnes et al., there is no corresponding expectation of success, and all elements of independent Claims 1 and 9 are not present in the references even if combined.

Initially, Applicant notes that the cited references, Speakman et al. and the present invention represent non-analogous arts. Speakman et al. teaches a financial analysis model via a specific software implementation, the In\$ite software package, for educational institutions. In contrast, Claim 1 addresses a computer based method for assessing the performance of an energy utility business.

Speakman et al is non-analogous because the focus of Speakman is the In\$ite software package for educational institutions. The present invention is directed to a performance based business evaluation of energy utilities. Applicant submits that any financial analysis of an educational institution cannot be directly related to a performance based business evaluation of an energy utility because the financial models, (i.e. public or

private funded schools versus entrepreneurial private utility business evaluation) are extremely different. Therefore, the detailed parametric analyses performed are vastly different.

Applicants also submit that there is no motivation to combine Speakman et al. with any other reference to arrive at the current invention recited in Claims 1-18. Applicants submit that one of skill in the art of private energy utility analysis would not begin her search with a school district financial analysis software package such as is taught by Speakman et al. Applicants can find no teaching or suggestion whatsoever in Speakman et al. that addresses an analysis of energy utilities. Applicants believe that use of the InSite software program would not produce results suitable for a financial analysis of an energy utility and that one of skill in the art would not attempt to stretch the incompatible school financial analysis teaching of Speakman et al. to arrive at the invention of Claims 1-18. Thus, there is little expectation for success that the specific teachings of Speakman et al. can be used for a method of assessing the performance of an energy utility. Speakman et al. is non-analogous art and a motivation to combine Speakman et al. with any other energy utility analysis reference would simply not occur to those of skill in the art.

Applicants also note that all the elements of the claims are not found in Speakman et al., Charnes et al., nor any combination of those references. For example, one element of Claim 1 recites, in part, "...retrieving performance data for the target utility from a database". This element cannot be found in Speakman et al. because Speakman et al. does not address energy utilities. However, the Examiner, in addressing this element of Claim 1, states on page 3 of the present Office Action, that Speakman et al. obviates the above element via Col. 18, lines 45-52. The citation from Speakman et al. reads as follows:

"As shown at 1801, assume \$11,000 in employee benefits needs to be distributed among three salary line items 1821-1823. The first line item is for a full-time instructor earning a salary of \$40,000. The second line item shown in 1822 is for a part time instructor earning a salary of \$20,000. The third line item is for a Food Service employee earning an annual salary of \$25,000 as shown in 1823."
(Speakman et al. Col. 18, lines 45-52).

Applicants notice that such an allocation of public school expenditures for education purposes is performed manually in the InSite software by a user (Speakman et al. Col 18 lines

27-31). The manual allocation of teacher's salaries has nothing in common with the Claim 1 element of "retrieving performance data for the target utility from a database." Speakman et al. fails to describe the above mentioned element of Claim 1. And, because Speakman et al. is directed to a non-analogous art, it also does not describe any of the other elements of the independent claims.

In addition, the use of Charnes et al. it does cure the deficiencies of Speakman et al., because Charnes et al. does not teach a multi-step method of assessing the performance of an energy utility as recited independent Claims 1 and 9. Charnes et al. teaches a *comparison* of DEA and existing ratio and regression systems for effecting efficiency evaluation of regulated electric cooperatives in Texas. Charnes et al. teaches that the findings of the *comparison* of DEA and ratio and regression systems indicate a potential for DEA to be a major part of the newer analytical approaches now being developed for use in regulatory activities. (Charnes et al., Abstract). For example, Charnes et al. does not explicitly describe the combination of steps (a) through (d) of Claim 1 nor the combination of steps (a) through (e) of Claim 9. Moreover, no combination of Charnes et al. and Speakman et al. would result in all the steps of these claims being performed.

For the foregoing reasons, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness under 35 U.S.C §103(a) (*See* MPEP 706.02(j)). Speakman et al. is non-analogous art, there is no motivation to combine, there is no expectation of success, and in any event, a combination of the teachings of Speakman et al. and Charnes et al. does not produce all the elements of the claimed invention. Therefore, Speakman et al., alone or in combination with Charnes et al., cannot render obvious independent Claims 1 and 9 and corresponding dependent Claims 2-8 and 10-18 respectively. Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of Claims 1-18 as they patentably define over the cited art.

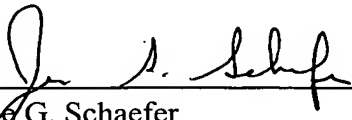
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Conclusion

In view of the above remarks, Applicants respectfully request withdrawal of the present rejection and reconsideration of all pending claims. Applicants respectfully and earnestly solicit a Notice of Allowance for all pending claims.

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